

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Application No. 10/529,271

Confirmation No. 2137

Applicant: Gunther Brandenburg

Filed: March 25, 2005

TC/AU: 2854

Examiner: MARINI, Matthew G.

Docket No.: 234700 (Client Reference No. PB04575)

Customer No.: 23460

**APPELLANTS' APPEAL BRIEF**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated December 24, 2009,  
Appellants now submit their Brief.

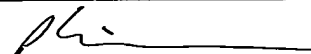
*Real Party In Interest*

The patent application that is the subject of this appeal is assigned to manrolad AG.

*Related Appeals and Interferences*

There are no appeals or interferences that are related to this appeal.

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<b>CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8</b> 540.00 DA			
I hereby certify that this Document and all accompanying documents are, on the date indicated below, <input checked="" type="checkbox"/> being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop , Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or <input type="checkbox"/> being facsimile transmitted to the U.S. Patent and Trademark Office, Facsimile Number (571) 273-8300.			
Name (Print/Type)	Phillip M. Pippenger, 46055		
Signature		Date	November 24, 2010

*Status of Claims*

Claims 12-22 are pending in this application. Claims 12-17 were rejected under 35 U.S.C. 103(a) over Billet (EP 1044915) in view of Hanlan (US 4,361,260). Claims 18-22 were rejected under 35 U.S.C. 102 over Billet (EP 1044915). Claims 12-22 herewith are appealed.

*Status of Amendments*

No outstanding amendments.

*Summary of Claimed Subject Matter*

Claim 12 encompasses a method for controlling a cut register of a web-fed rotary press. *See* Abstract. The cut register represents placement of cuts on a web. *See* [0016]. The method includes guiding a web leaving a last printing unit of the rotary press to a cross-cutting device via at least two pulling units with adjustable leads. *See* [0008], FIG. 1, element Z3. The system eliminates the need for a movable tensioning roller between the at least two pulling units. *See* FIG. 1, Z1 and Z2. The pulling units are independently rotatable from one another and from the cross-cutting device. *See* [0008]. With this configuration, changing a circumferential speed of at least one of the pulling units adjusts the cut register. *Id.*

Claim 18 apparatus for controlling a cut register of a web-fed rotary press having a web guided from a last printing unit to a cross cutting device via a plurality of pulling units. *See* FIG. 1 and [0008]. The pulling units are independently rotatable from one another and from the cross-cutting device. *Id.* The system eliminates the need for a movable tensioning roller between the pulling units and includes a controller connected to a motor of at least one of the pulling units. *See* FIG. 1, Z1 and Z2. It further includes a first cut-register sensor to detect a first actual value of the cut register on the web and feed the detected value to the controller. *See* [0015]. The controller controls the motor to adjust a speed of the pulling unit based on the first actual value of the cut register. *Id.*

*Grounds of Rejection to be reviewed on Appeal*

Rejection of claims 18-22 were rejected under 35 U.S.C. 102 over Billet (EP 1044915).

*Argument*Claims 18-22

Claims 18-22 were rejected under 35 U.S.C. 102 over Billet. Applicants respectfully submit that the cited art does not anticipate or make obvious any pending claim. Turning first to claim 18, this claim contains numerous important limitations that are nowhere addressed in the Action. For ease of reference, claim 18 is reproduced below:

18. An apparatus for controlling a cut register of a web-fed rotary press having a web guided from a last printing unit to a cross cutting device via a plurality of pulling units, wherein the pulling units are independently rotatable from one another and from the cross-cutting device, there being no movable tensioning roller between the pulling units, and the cut register representing placement of cuts on the web, the apparatus comprising:

a controller connected to a motor of at least one of the pulling units; and

a first cut-register sensor disposed to detect a first actual value of the cut register on the web and feed the detected first actual value to the controller, wherein the controller controls the motor to adjust a speed of said at least one pulling unit based on the first actual value of the cut register.

As can be seen, the claim requires a plurality of pulling units configured in a certain manner. While the Action alleges that limitations in the preamble can be ignored, this is not a correct statement of law. Limitations in the preamble can be disregarded ONLY WHEN the remaining structural limitations can stand alone, i.e., without the preamble. This is quite clearly not the case here. Consider the claim without the preamble:

18. (without preamble) An apparatus comprising:

a controller connected to a motor of at least one of the pulling units

**--What pulling units?**

**--How many?**

**--What are they pulling?**

**-- Where are they?; and**

a first cut-register sensor disposed to detect a first actual value of the cut register

**--What cut register?**

**--What does it even represent?"**

on the web and feed the detected first actual value to the controller, wherein the controller controls the motor to adjust a speed of said at least one pulling unit based on the first actual value of the cut register.

Clearly, the remaining claim limitations could not stand on their own - in fact, the preamble provides the necessary antecedent basis for multiple elements within each of the remaining claim imitations.

This is not a close case that requires a judgment call - this is an extreme case, and it is one that the Federal Courts have already decided in Applicants' favor. Please see *Bicon Inc. v. Straumann Co.*, 78 USPQ2d 1267 (Federal Circuit 2006) (preamble *is limiting* if limitations in body of claim rely upon and derive antecedent basis from preamble); see also *Eaton Corp. v. Rockwell International Corp.*, 66 USPQ2d 1271 (Federal Circuit 2003) ("The ... steps ... require the manipulation of particular structures that are identified and described only by the preamble, ... We therefore conclude that the preamble ... limits the claimed invention".)

Further, please note that the Federal Circuit did not leave any room to assume that such preambles might nonetheless be considered to state only a purpose or intended use. Indeed, the Federal Circuit explicitly criticized and rejected that line of reasoning with respect to cases where the preamble is required for antecedent basis. See *Eaton* at p. 1277 ("Claim 14 [wherein preamble provides antecedent basis] is an example of the claim drafter choos[ing] to use both the preamble and the body to define the subject matter of the claimed invention...as opposed to a preamble reciting an intended use for an invention") (internal citations omitted).

Thus, as a clear legal matter, the preamble of claim 18 cannot be ignored. Thus, numerous significant limitations of the claim have been improperly ignored. As such, a prima facie case of unpatentability has not been presented with respect to claim 18, and allowance of claim 18 is requested.

Dependent claims 19-22 are believed to be patentable for the same reasons.

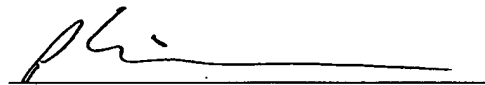
Claims 12-17  
~~18-22~~

Claims 12-17 were rejected under 35 U.S.C. 103(a) over Billet (EP 1044915) in view of Hanlan (US 4,361,260). With respect to independent claim 12, the Action admits that Billet fails to teach a system of pulling rollers without a movable tensioning roller between them. However, seeing that Hanlon lacks such a roller, the Action suggests that it would be obvious to simply remove the tensioning roller from Billet as well. Not only would such a move be nonobvious, it would be vandalism -- the resulting system would utterly fail to function. Indeed, the system of Billet clearly *relies* on the tensioning roller to function. Indeed, as will be easily appreciated, Billet's system performs "stop cutting" (i.e., the web at the cutter is stopped momentarily during the cut). As noted in Billet, and as those of skill in the art know, such stop cutting is only possible with the use of a tensioning roller to take up slack when the web stops at the cutter but is still moving elsewhere. Thus, if Billet's tensioning roller were removed, not only would Billet's particular improvement no longer work, but the entire press would fail because the web would be torn apart as part of it stops and part of it keeps going.

Thus, it would not have been obvious or even possible to remove the tensioning roller from Billet's system, and thus favorable reconsideration of claim 12 is requested.

Because independent claim 12 is patentable as discussed above, it is submitted that the remaining dependent claims are also patentable for at least these reasons, and favorable reconsideration of all pending claims is requested.

Respectfully submitted,



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Date: November 24, 2010

*Claims Appendix*

1-11 (Canceled)

12. (Previously Presented) A method for controlling a cut register of a web-fed rotary press, the cut register representing placement of cuts on a web, the method comprising:

guiding a web leaving a last printing unit of the rotary press to a cross-cutting device via at least two pulling units with adjustable leads, there being no movable tensioning roller between the at least two pulling units, and wherein the pulling units are independently rotatable from one another and from the cross-cutting device: and

changing a circumferential speed of at least one of the pulling units to adjust the cut register.

13. (Previously Presented) A method as in claim 12, wherein the step of changing includes: detecting a first actual value of the cut register using a first cut-register sensor; feeding the detected first actual value of the cut register to a controller; comparing, by the controller, the detected actual value of the cut register with a cut-register setpoint value representing a predetermined desired placement of a cut on the web; adjusting, by the controller, a motor of said at least one pulling unit to change the circumferential speed.

14. (Previously Presented) A method as in claim 13, further including: providing a second cut-register sensor positioned at a second pulling unit upstream of said at least one pulling unit; detecting a second actual value of the cut register using the second cut-register sensor; deriving a differentiating proportion from the first and second actual values of the cut register; and applying, by the controller, feedforward control based on the differentiating proportion.

15. (Previously Presented) A method as in claim 13, further including: determining an actual state of the cut register based on a mathematical model; deriving a differentiating proportion from the actual state of the cut register; and applying, by the controller, feedforward control based on the differentiating proportion.

16. (Previously Presented) A method as in claim 13, further including: supplying by the controller to a second pulling unit downstream of said at least one pulling unit a second setpoint value for controlling a lead of the second pulling unit.

17. (Previously Presented) A method as in claim 13, further including compensating by the controller a counteractive effect by forces of the web on a torque of the motor of said at least one pulling unit.

18. (Previously Presented) An apparatus for controlling a cut register of a web-fed rotary press having a web guided from a last printing unit to a cross cutting device via a plurality of pulling units, wherein the pulling units are independently rotatable from one another and from the cross-cutting device, there being no movable tensioning roller between the pulling units, and the cut register representing placement of cuts on the web, the apparatus comprising:

a controller connected to a motor of at least one of the pulling units; and

a first cut-register sensor disposed to detect a first actual value of the cut register on the web and feed the detected first actual value to the controller, wherein the controller controls the motor to adjust a speed of said at least one pulling unit based on the first actual value of the cut register.

19. (Previously Presented) An apparatus as in claim 18, further including a second cut-register sensor connected to the controller and disposed at a second pulling unit upstream of said at least one pulling unit, the second cut-register sensor detecting a second actual value of the cut register and feeding the second actual value to the controller, the controller applying feedforward control based on the second actual value.

20. (Previously Presented) An apparatus as in claim 18, further including a computing unit connected to the controller, the computing unit calculating an actual state of the cut register based on a mathematical model. the controller receiving the calculated actual

22. (Previously Presented) An apparatus as in claim 18, wherein the controller controls said at least one pulling unit to compensate for a counteracting effect by forces of the web on a torque of the motor of said at least one pulling unit.



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*Evidence Appendix*

None

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*Related Proceedings Appendix*

None